REMARKS

Claims 102-129 are pending, of which claims 102, 113 and 122 are in independent form.

Claims 102, 105-108, 110, 111, and 113-129 have been amended by way of this response to better define the scope of the subject matter for which protection is being sought. Support for the claim amendments may be found in the present patent application at various places. See, e.g., Paragraphs [0046] and [0055] of U.S. Patent Application Publication No. 2001/0005857 that corresponds to the present patent application.

Favorable reconsideration of the present patent application as currently constituted is respectfully requested.

Regarding the Provisional Double Patenting Rejections

In the Final Office Action of October 13, 2006, claims 102-129 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 126-212 of co-pending U.S. Patent Application No. 10/207,418 as well as over claims 90-109 of co-pending U.S. Patent Application No. 09/782,107. Applicant appreciates the alleged correspondence drawn by the PTO between the pending claims and the respective sets of conflicting claims. Without acquiescing in the correspondence

between the claim sets, Applicant is submitting herewith applicable terminal disclaimers in accordance with 37 C.F.R. §1.321. Accordingly, it is believed that the pending double patenting rejections have been overcome hereby.

Regarding the Objections to the Specification

In the pending Office Action, the specification stands objected to "as failing to provide proper antecedent basis for the claimed subject matter." In response, Applicant has appropriately amended the specification as required by the Examiner. Applicant respectfully submits that programs or software code operating on a computer are well known to be stored on a computer-accessible medium. Accordingly, no new matter is believed to have been added.

Regarding the Rejections under 35 U.S.C. §101

Claims 113-121 are rejected in the pending Office Action under 35 U.S.C. §101 as being directed to non-statutory subject matter. Without necessarily acquiescing in the position put forth in the pending Office Action in this regard, Applicant has appropriately amended claims 113-121. It is therefore believed that the §101 rejections have been overcome or otherwise rendered moot.

Regarding the Claim Rejections - 35 U.S.C. §103

All pending claims were rejected under 35 U.S.C. §103(a) in the Final Office Action of October 13, 2006 based on a number of combinations of applied references. The pending Office Action maintains the same rejections. It is noted that the combination of AirMobile™ Wireless Communication Client for cc:Mail User Guide Version 1.0, Communication Client Guide, 1995 (hereinafter *AirMobile Client*, or *AirMobile* for short) and MAPI Developers Forum post "MAPI Notification" April 12, 1996 (hereinafter *Carthy*) continues to be principally relied upon to support the rejection of the pending claims under 35 U.S.C. §103(a).

Upon review of the comments provided in the Final Office Action of October 13, 2006 as well as the present Office Action with respect to the foregoing §103 rejections, Applicant respectfully submits the following.

I. *AirMobile* as a Primary Reference is Inherently Deficient

AirMobile is directed to an email forwarding scheme over a wireless network wherein two types of messaging delivery models are disclosed: (i) a "client poll" model and (ii) a "server push" model. The "client poll" model involves polling from the user's standpoint, i.e., the user needs to poll the host system by sending

a request on a periodic basis to effectuate delivery of email messages from the host system to the user's device. The "server push" model, on the other hand, does not require the user to initiate contact with the host system to retrieve email messages. *AirMobile* describes the "server push" model as excerpted below:

> With Motorola Air*Mobile*, messages are "pushed" out to your portable PC from the server over the wireless network; you do not have to constantly call in to check for messages. This implementation of "server push" eliminates unnecessary communication between the client and server, minimizing communication costs and artificial delivery delays.
>
> When you send a message while Motorola Air*Mobile* is running, the message will be immediately processed from your outbox, assuming it passes your upload filters, and be delivered to your LAN-based cc:Mail server for ultimate delivery.
>
> When a message arrives for you in your LAN-based cc:Mail inbox, Motorola Air*Mobile* software will immediately download the messages to your laptop, assuming it passes your download filters, placing it in your cc:Mail Mobile inbox. See page 31 of the Air*Mobile Client* reference, at paragraphs 1-3.

Applicant agrees that the *AirMobile Client* reference appears to define the "server push" model as one that does not involve polling from the standpoint of a user. This is not to say, however, that the AirMobile system is not a polling system.

Specifically, the companion *AirMobile Server*[1] reference provides that AirMobile (AM) server software is ***required to poll*** a user's inbox at the mail server at a predetermined scheduler cycle period. See page 23 of the *AirMobile Server* reference, at paragraph 1. Additionally, the AM server software is also required to poll the mail server at a predetermined inter-user time-out period. See page 23 of the *AirMobile Server* reference, at paragraph 2. In other words, the email forwarding scheme disclosed in the *AirMobile Server* and *Client* references is in fact a polling-based system that requires at least two polling processes by the AM server software.

Accordingly, the scheme disclosed in *AirMobile* as a "server push" messaging model does not teach or suggest the presently claimed pushing of user data items from a messaging host system to a wireless mobile data communication device involving receiving and processing an automatically generated notification at a redirector component. In the claimed embodiments of the present disclosure, the automatically generated notification is used for detecting by the redirector component of the receipt of a user data item by the messaging host system, thereby obviating the need for the server polling required in *AirMobile*.

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[1] AirMobile™ Wireless Communication Server for cc:Mail User Guide Version 1.1, Communication Server Guide, 1995.

In fact, the PTO has conceded that *AirMobile* fails to "specifically recite 1) that the *notification* is *automatically generated* in response to receipt of the user data item ...". See Final Office Action of October 13, 2006 at page 8.

II. Deficiency of *AirMobile* Cannot be Cured as Suggested in the Final Office Action

With respect to the foregoing critical deficiency of *AirMobile*, the following comments were provided in the Final Office Action of October 13, 2006:

> With regard to point (1), AirMobile failed to specifically recite that the *notification* is *automatically generated* in response to receipt of the user data item. AirMobile disclosed a server side push technology (pg 31 ¶1-3), where the server must internally poll for the arrival on new messages in a user's mailbox. Nonetheless, Examiner maintains that <u>such an automatic notification must occur in the system</u> in order for the actual forwarding software to be invoked within the computer system. Furthermore even if one were to argue persuasively that such a notification is not inherent then Examiner maintains that adding a new data item automatic notification feature would have been an obvious modification to AirMobile at the time of Applicant's invention, in view of at least Carthy. See Final Office Action at page 8 (Emphasis added).

In response, Applicant provides the following arguments to rebut the foregoing contentions.

A. *AirMobile* Explicitly Teaches Polling by Server Software

Contrary to the unsupported assertion that "such an automatic notification must occur in the system...", the *AirMobile* system is in fact a server polling system as discussed hereinabove. In addition, *AirMobile* is replete with references to the polling mechanism required for forwarding messages. For instance, the System Configuration menu of the *AirMobile* system requires configuration of a Scheduler Cycle Time parameter which defines the number of seconds to wait between Outbox checking. In particular, it is provided that:

> Scheduler Cycle Time: Defines the number of seconds to wait between Outbox checking. For example, if you enter "60" in this field, your outbox will be checked every 60 seconds for the messages to be sent. Note that 30 seconds is the minimum scheduler cycle time. See *AirMobile Client* at page 20.

Similarly, it is also provided in the companion *AirMobile Server* reference that the Scheduler Cycle Time parameter defines the number of seconds to wait between checking each active user's inbox for the presence of messages. See *AirMobile Server* at page 23. Further, the *AirMobile* server software has an inter-user time-out function that "defines the number of seconds to wait between

checking the next user's inbox." See *Id.* This parameter in the *AirMobile* server software is operable "to space out inquires to a mail server." See *Id.* Accordingly, to the extent Applicant understands the PTO's position, it is respectfully submitted that the assertion that there must be an automatic notification within the *AirMobile* system in order for invoking the forwarding of a message is untenable.

B. Reliance on Combination with *Carthy* is of No Avail

Additionally, the *Carthy* reference is relied upon in order to cure the deficiency of *AirMobile* for purposes of maintaining the pending §103 rejections. The following remarks were provided in the Final Office Action of October 13, 2006 in this regard:

> In a similar art, Carthy disclosed an e-mail system where the notification of new messages in a user's mailbox is sent **automatically**, as opposed to polling, using an extended MAPI IMAPIadviseSink notification (See the Carthy post describing "full asynchronous" notification in extended MAPI). Carthy further disclosed that in order to receive these automatic notifications the system must register with a software interface associated with the messaging server (i.e., registering with the ImsgStore to receive adviseSinks). ... Automatic notification is preferable to polling for detecting the arrival of new messages since the detection process is more efficient. ... Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the automatic notification

> functionality disclosed by Carthy within AirMobile's system, since Carthy disclosed automatic notification is preferable to polling and further since the use of automatic notification is more efficient. Again automatic notification is more efficient since the system is alerted immediately of the arrival of new messages and less system resources are consumed. See Final Office Action at pages 8-9.

Applicant respectfully traverses and submits the following discussion.

B1. Combining *Carthy* Requires Impermissible Modification of *AirMobile*

It is well established that if a proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). That is, if the primary reference describes a claim element having a particular limitation, and the secondary reference or references describe the same claim element having the opposite limitation, or a different limitation, the principle of operation of the primary reference would have to be changed in order to combine the references, in violation of MPEP 2143.02(VI). To the extent the *AirMobile* system is being relied upon as the prior art

invention that is being modified, one must accept that the server polling mechanism is the essential principle of operation thereof. As can be seen from the foregoing discussion of *AirMobile*, to advance a contrary proposition would be a gross mischaracterization of the teachings of *AirMobile*. Accordingly, whatever modification that is being relied upon, it should not alter the core functionality of the interface between the *AirMobile* server software and the messaging system. To suggest a wholesale replacement of the server polling interface with another interface that functions diametrically opposite (i.e., an interface that entirely obviates the need for polling by an application software program for detecting arrival of messages at a mail server, precisely the type of modification that *Ratti* proscribes) would essentially eviscerate the *Ratti* rule because the basic architecture of *AirMobile* will then be fundamentally altered.

B2. There is No Reasonable Expectation of Success if *AirMobile* and *Carthy* were to be Combined

Since it appears that the PTO has not met the initial burden of factually supporting the conclusion that the art of the record provides a sufficient basis for a reasonable expectation of success if the *AirMobile* and *Carthy* were to be combined, Applicant

respectfully submits that a *prima facie* case of obviousness has not been established. Relatedly, whether a proposed modification or combination of the prior art has a reasonable expectation of success must be determined at the time the invention was made. *Ex parte Erlich*, 3 USPQ2d 1011. For purposes of the present patent application, the threshold query under the foregoing principles then becomes: Do the teachings of *AirMobile* and *Carthy* either alone or in combination provide a sufficient basis for a reasonable expectation of success if they were to be combined, evaluated from the perspective of at the time the claimed invention was made? Applicant respectfully submits that they do not. The primary reference, i.e., *AirMobile*, does not have any basis whatsoever with respect to reasonable expectation of success if it were combined with a non-polling based message detection mechanism since it is concerned with a totally different email detection and forwarding architecture.

Furthermore, it is known that the *AirMobile* server software interfaces with the mail server using the Vendor Independent Messaging (VIM) Interface. It is also known that VIM was a directly competing Application Programming Interface (API) with respect to the MAPI interface at the time of the invention. In fact, both VIM and MAPI were seen as two competing, altogether

different interface standards for electronic messaging platforms. In essence, therefore, one cannot combine VIM with MAPI; rather, a developer will have to replace one API platform with the other platform *in toto*. Such wholesale replacement of APIs in a highly integrated software platform such as the *AirMobile* server software militates against a reasonable expectation of success, especially during the time period when the claimed invention was made.

B3. *Carthy* does not Include Sufficient Information to Provide a Basis for Reasonable Expectation of Success

The *Carthy* reference is a user group post directed to a response to a user question regarding the use of MAPI notifications. Specifically, the requester (stephane COHEN) stated that:

> I want to notify an incoming message in any mailbox of my Exchange Server without connecting to the mailbox. In fact, I'd like to use something like a "full asynchronous" notification, without connection.
>
> Today I do a polling on each mailbox : I open a connection through MAPI functions, I consult, I notify if new mail, and I close the connection. Then I go to the next mailbox and do the same actions. It's not great :-(.
>
> So I'd like to know wether exists another way to notify with MAPI, especially a "full asynchronous" notification.

In response thereto, Ciaran Carthy stated that:

> "full asynchronous" notification is fully supported in extended MAPI.
>
> Assuming you have a pointer to Imsgtore object, do the following:
>
> ...
>
> Please refer to the mapi programming docs for an explanation of Advise function, and the IMAPIADVISESINK interface.
>
> You implement the IMAPIADVISESINK object which gets called back by MAPI when new mail arrives at the message store. However the notification "link" is only alive while you have the ImsgStore object open, so you must stay "connected".

A close reading of the above passages indicates that whereas the requester is interested in using "fully asynchronous" notification without a connection, the respondent's reply provides that one must stay "connected" to receive any notifications. To the extent the respondent's reply does not appear to fully address the initial query posed by the requester, there seems to be no bearing on how a polling-based software application may receive notifications without a "live" connection to the messaging server. Accordingly, *Carthy* does not provide a sufficient basis for a reasonable expectation of success if it were to be combined within the *AirMobile* system.

At least for the foregoing reasons, Applicant respectfully submits that the combination of *AirMobile* and *Carthy* references does not support a *prima facie* case of obviousness of the pending claims under 35 U.S.C. §103(a). Accordingly, it is believed that the pending claims as currently constituted are allowable over the art of record.

Reservation of Rights

Notwithstanding the foregoing, Applicant reserves all rights not exercised in connection with this response, such as, e.g., the right to challenge or rebut any tacit or explicit characterization of any reference or of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections of the present Office Action, the right to swear behind any cited reference such as provided under 37 C.F.R. §1.131 or otherwise, the right to present a showing of secondary considerations in the instant application by way of one or more supplemental submissions under 37 C.F.R. §1.132, or any and all other rights and remedies available under the Patent Statute.

Fee Statement

Compared to the highest number previously paid for, the number of independent claims has remained the same and the total number of claims has been remained the same. Applicant is filling herewith a petition for a THREE-month extension of time. Additionally, two terminal disclaimers are being filed herewith. Accordingly, payment of all applicable via electronic filing is being authorized in the appropriate amount. Applicant believes no additional fees are due for the filing of this response. If any additional fees are due or any overpayments have been made, however, please charge or credit our deposit account (Deposit Account No. 03-1130).

SUMMARY AND CONCLUSION

In view of the fact that none of the art of the record, whether considered alone or in combination discloses, anticipates or suggests the present embodiments, as now defined by the independent claims, and in further view of the above amendments and/or remarks, reconsideration of the Action and allowance of the present patent application are respectfully requested and are believed to be appropriate.

Respectfully submitted,

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